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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,534	02/03/2003	Catia Bastioli	13929/T/B/A	7100
7590 09/29/2008				
Byran Cave LLP 1290 Avenue of the Americas 33rd Floor New York, NY 10104			EXAMINER SAYALA, CHHAYA D	
			ART UNIT	PAPER NUMBER
			1794	
			MAIL DATE	DELIVERY MODE
			09/29/2008 PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments filed 9/8/2008 have been fully considered but they are not persuasive.

Applicant's amendment of claim 14 will not be entered. Claim 14 has been amended to read as a product-by-process claim, no different from claim 12 that remains rejected and therefore, since the amendment does not advance the patentability of the claims by this amendment.

MPEP 2113 states as follows:

The structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product. See, e.g., *In re Garnero*, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979).

There is no evidence that the process steps by which the product is made are unique or that the product can only be defined by the process steps.

With reference to Goehl, applicant has focused on the process by which the product was made in order to establish patentability. Again, applicant is reminded that the claim in question is a product claim. Applicant's claim is drawn to an article that can

be chewed on, and which contains inulin (or other fructooligosaccharides) and thermoplastic polymers, that are capable of being thermoplastically processed.

With reference to Soon-Shiang, applicant's criticism that the examiner has not pointed out examples showing inulin, is not a criteria that can be used to withdraw this rejection, when the *claims of the reference* clearly anticipate the same subject matter. There is no requirement under 35 USC 102, that the reference's claimed subject matter be ignored because the patent does not show an example.

The rejections over Guttag and van Haveren are being maintained and the arguments are deemed moot because they are based on the amendment that has not been entered.

With regard to the examiner missing the mark, and the fact that "one would not be motivated to use inulin because its molecular mass is so low" and that the artisan would not expect success in converting it to a thermoplastically processable material, first, the motivation has been clearly shown thus:

Both patents do not teach inulin. However, inulin, a polysaccharide, is known to be a stabilizer for extrudable thermoplastics. See Van Haveren et al (col 2, line 62-64 and abstract). Also, Bengs et al. teach a mixture of starches including inulin, used in biodegradable thermoplastic materials that can be thermoplastically processable using techniques such as injection molding or extrusion. Col 1, line 32, col 2, lines 58, col 3, lines 20-21, col 4 line 66-67, col 5, lines 21-28. Note that the *mixture* of starches is given to be in an amount 33-90%.

Ananthararman et al teach the use of inulin in pet food products is beneficial in an amount of at least 0.25%. See col 1, which states that inulin promotes bifido- and lacto-bacteria in the GI tract at the expense of pathogens and is very beneficial for animals and inulin has been used as a vet diet for pets.

Assertion that examiner combines prior art references for purpose different from that envisioned by inventors does not warrant reversal of examiner's finding of obviousness.

Ex parte Raychem Corp. 17 USPQ2d 1417.

Second, the result of a cursory search of the process steps is the patent provided on PTO form 892, which shows at Example 3, the very same process used by applicant with the same steps, showing that the process was old and known and the question of an expectation of success is not an issue.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Sayala whose telephone number is (571) 272-1405. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For

Art Unit: 1794

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**/C. SAYALA/  
Primary Examiner, Art Unit 1794**